Supreme Court of the United States,

IN EQUITY.

No. 223.

PAUL C. COFFIN,

Appellant,

vs.

JAMES B. OGDEN

and

LUCIUS WOODRUFF.

Appeal from the Circuit Court for the Southern District of New York.

BRIEF FOR THE APPELLEES.

BENJ. F. THURSTON,

STEPHEN D. LAW,

Of Counsel for Appellees.

NEW YORK:

JOHN POLHEMUS, PRINTER, 102 Nassau Street, cor. Ann.

1873.

Supreme Court of the United States.

PAUL C. COFFIN,
Appellant,

vs.

JAMES B. OGDEN and LUCIUS WOODRUFF.

In Equity. (Appeal from the Circuit Court for the Southern District of New York). *Case reported in 7 Blatch.*, 61.

BRIEF FOR THE APPELLEES.

This is a bill in equity, brought by the plaintiff as owner of the Letters Patent for an improvement in locks and latches, granted to one William S. Kirkham, June 11, 1861, to restrain the defendants from selling a certain variety of reversible door latches, manufactured by the Russell & Erwin Manufacturing Co., of New Britain, Conn. The Letters Patent upon which the suit is founded were assigned to one Charles A. Miller, and by him, as assignee, they were surrendered and re-issued with an enlarged claim, Jan. 27, 1863. The re-issued Letters Patent were conveyed to the complainant, June 10, 1864.

Reversible locks, or those which admit of the turning of the latch, so as to render the lock applicable to either a right or a left hand door, were known and in use before the alleged invention of Kirkham, and his patent professes to describe an improvement in

the manner of constructing such locks. The improvement described consists in dividing the hub, or that portion through which the turning-knob spindle passes, into two parts, one of which is immediately connected with the tail of the latch, while the other is held in a fixed position by the walls of the lock. When the spindle is inserted in the hub, the two parts will be as one, but, if the spindle be withdrawn, the portion connected with the latch being separate from the portion held by the case, will present no impediment to the extension of the square of the latch head beyond the face plate. After the act of turning the latch has been performed, a spring restores the movable part of the hub to its proper relation with the other portion, so that the spindle mortises in both will be in coincidence.

The accompanying cut, Fig. 1, shows the latch mechanism of the Kirkham lock. The description in the specification of the re-issue patent will be found on pages 26–28 of the Record.

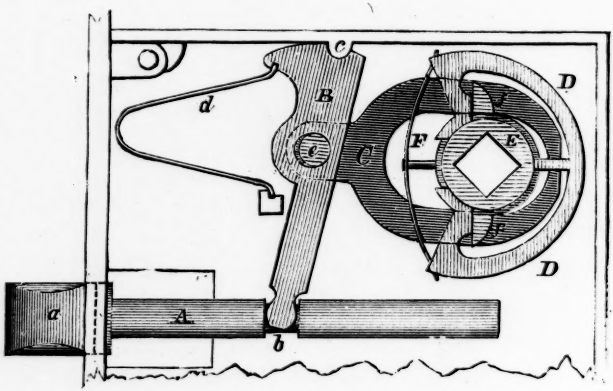

Fig. 1.

It is quite obvious from an inspection of the exhibit presented with the patent that the structure of the hub is too complicated and expensive to be adopted by practical lock makers, and in fact it does

not appear that more than two specimens of the lock were ever made by him or by his assignees. (*A. M. Hill*, Record, p. 69; Q.. 9—23. It is certain that the structure has never gone into use in the form exhibited in the patent).

The defendants have sold locks manufactured by Russell & Erwin Manufacturing Co., under a patent granted to Asa T. Brooks, subsequent in date to that granted to Kirkham. The locks complained of have a hub made in three parts, the middle portion connected with the latch being free to be moved far enough to admit of the reversal of the latch when the spindle is withdrawn. In the form and the construction of its parts it is different from the hub shown in the Kirkham patent, but it undoubtedly makes use of a divided, as distinguished from a solid hub.

The accompanying cut, Fig. 2, represents the lock manufactured and sold by the defendants.

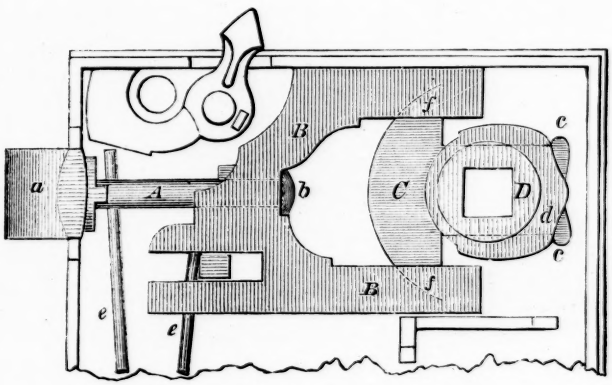

Fig. 2.

THE KIRKHAM PATENT IS INVALID ON ITS FACE.

Without reference to the question of fact hereafter to be considered, the two specifications of claim ap-

pended to the Kirkham re-issue patent are invalid by reason of their assuming to claim an effect or function.

The language of the claim is—

> 1st. So dividing the hub or follower, and so combining the same with a reversible latch, that the arms, or their equivalents, of the divided hub, or follower, may be released for the purpose of allowing the latch to be reversed or turned.
>
> 2d. So constructing and arranging the individual parts of a divided hub, or follower, that the reversal or turning of the latch is prevented only by the presence of the spindle within the lock.

Clearly every form of divided hub, allowing the arms of the follower to be released for the purpose of allowing the latch to be reversed, and every lock whose hub is so constructed that the presence of the spindle prevents the latch from reversing, falls within this specification of claim. No reference whatever to the body of the specification, indicating the characteristics of construction necessary to bring the structure within the claim by the words "substantially as described," is to be found.

O'Reilly vs. Morse, 15 How., 112.
Burr vs. Duryea, 1 Wall., 531.
Case vs. Brown, 2 Wall., 320.
Sickles vs. Falls Co., 4 Blatch., 508.
Burr vs. Cowperthwaite, 4 id., 163.

BUT KIRKHAM was not the first and original INVENTOR OF THE THING CLAIMED IN HIS PATENT as new.

The defendants, by their answer, assert that a lock possessing the same characteristics and combination of parts was invented by one Barthol Erbe, of Pittsburg, anterior to the alleged invention by Kirkham.

The accompanying cut, fig. 3, represents the Erbe Lock.

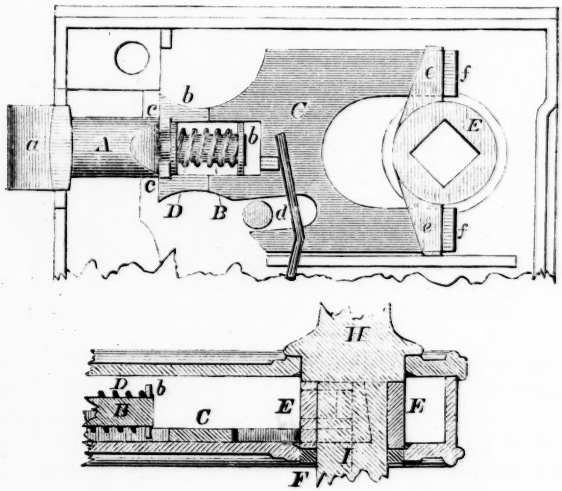

Fig. 3.

There can be no doubt that the lock made by Erbe is, with respect to the means by which the latch is reversed, identical in principle with that made by Kirkham, not only from an inspection and comparison of Exhibits C (pltff.) and A (defts.), but from the testimony of the experts examined by both parties.

E. S. Renwick's deposition (Record), page 13, Cross-Q. 13.

H. B. Renwick's deposition, page 55, Q. 3.

Kirkham filed his application for a patent on the —— day of May, 1861. The original patent is dated June 11, 1861.

Erbe had constructed a complete lock by the 25th

of December, 1860, exhibited it at or about that time to various persons, and the lock itself, in the early part of 1861, was placed for trial upon the counting room door of his employers.

The testimony establishing these facts is as follows:

BERNHARD BROSI (Record, page 29), testifies that he has been acquainted with Erbe for 17 years. At Christmas time, in 1860, the witness called at Erbe's house (Q. 9), and was shown a lock which is fully described by the witness, and is declared to have been identical with Defendants' Exhibit A. Erbe Lock, (Q. 17). He saw the same lock afterwards at Jones, Wallingford & Co.'s (Q. 20—21), and knows that it was placed on a door at the works (Q. 22). The witness is certain as to the dates given by him (Q. 14–16).

In cross-examination he states that Erbe and he were shop-mates in the same room in the factory (Q. 58); that the occasion when Erbe made the lock was while the works was stopped, which occurred immediately after the Presidential election of 1860 (Cross-Q. 60, 66), that in the course of six months or so the works started again, and Erbe made two more locks of the same kind (Cross 100–110). He is particularly examined as to the persons who, at the time when the lock was placed on the door, occupied the office, and would know the fact, and he gives the names of the persons (Q. 126).

HENRY MASTA (Record, page 40) states that he is a pattern maker by trade, and was, during the year 1860, in the employ of Jones, Wallingford & Co. He has been acquainted with Erbe, who was employed during the same year by this firm, for fifteen years. He testifies, that on New Year's Day, 1861, Erbe was on his way to church, and stopping by the way at the house of the witness, exhibited to him a lock, which he fully describes and identifies as cor-

responding with Exhibit A (Q. 6–12). He fixes the year as 1861, by the fact that he moved upon a farm in March, 1861, and commenced to build himself a house in April of that year (Q. 13–16). He asserts that he cannot, by any possibility, be mistaken as to the date when he saw Erbe's first lock (Q. 21–23). Erbe himself moved upon a neighboring farm in the same month, but both continued to work during the winter seasons for Jones & Nimick Manufacturing Co., successors of Jones, Wallingford & Co.

ANDREW PATTERSON (Record, page 45) testifies, that during 1860, and until March, 1864, he was superintendent of Jones, Wallingford & Co.'s factory in Pittsburg. This concern suspended work in November, 1860, and did not resume operations for several months (Q. 2, 3). Erbe has been employed since 1856, for the most of the time, in the same factory with the witness. About January 1st, 1861, Erbe exhibited to witness a reversible latch, like Exhibit A, in all material respects, and so far as the means are concerned which enable it to be reversed, identical in principle and mode of operation (Q. 4–6). It was the uniform practice of the company to place new contrivances in locks into use to test their value, and witness believes that the Erbe lock was placed upon a door, but at this distance of time he will not say positively that this was so (Q. 7). The witness is certain that he saw Erbe's invention at the time stated, from connecting the circumstance with the suspension of the business of the factory, and also from a date inscribed upon a testimonial watch presented to him by the workmen of the factory (Q. 10).

Upon cross-examination he states that Erbe showed him four different improvements in reversible latches; the first was in 1859, and the one in question the third in the order of time. The company at the time were involved in a lawsuit with the owners of the Janus-faced case, and being under injunction (*Jones* v. *Morehead*, 1 Wall., 156), they

could not make use of Erbe's various improvements without jeopardizing their position. (Cross-Q. 13–38.)

The identity between the principle of the reversible latch made by Erbe in 1860, and that shown by Exhibit A, is proved by M. J. WOODRUFF. Exhibit A was made by Erbe in compliance with Mr. Woodruff's request, and for use in this case. Mr. Woodruff also endeavored to procure Erbe's attendance in New York as a witness before the Examiner, but Erbe, though willing to come with the witnesses, Brosi, Masta and Patterson, was prevented by Mr. Jones, in whose employ he was at the time. It appears that Mr. Jones, for some reason not pertinent to the issue, was not disposed to afford the defendants any facilities for getting their testimony.

Woodruff's dep., page 49, Q. 5.

By a stipulation subsequently made between counsel, Erbe's deposition was taken by the complainant on interrogatories appended to a commission.

He testifies (Record, page 23, also page 25, for affidavit referred to in defendants' interrogatory,) that he made Exhibit A in July, 1868, at the request of the defendants. He made the original lock in the latter part of 1860. He made three others at different times. He believes that the original lock which he gave to Jones, Wallingford & Co. was put on a door, but he does not know the fact.

If any fact is capable of being established by testimony, it is proved that Barthol Erbe completed a lock as early as December 25, 1860, which contained a reversible latch substantially identical with that described in Kirkham's patent of June 11, 1861.

Besides, too, all the facts attending Erbe's invention were known to Jones, Wallingford & Co., who are accessible to the complainant, to disprove the allegation that the invention was made at the time

stated, or to deny that a complete working lock was placed during the Winter of 1860–61 upon a door in their counting-room, if they could conscientiously do so.

THE COMPLAINANT FAILS TO ANTE-DATE ERBE'S INVENTION.

The complainant, for the purpose of proving that Kirkham was the prior inventor to Erbe, calls *Charles A. Miller*, the plaintiff's assignor, and the person who, as assignee of Kirkham, procured the re-issue patent in suit. He testifies that during the year 1860, and for some years previously, he was agent for the sale of the locks of the Squire & Parsons Mfg. Co., Brandford, Ct. Kirkham was superintendent of the manufactory of the company. (Record, page 14.) It seems that the witness and Kirkham had, during 1859, an understanding, which was kept secret from the company, to start the lock business together in Philadelphia. (Q. 6, Cross-Q. 95–97.) Miller had been engaged in selling locks applicable to a right or left hand door, and urged Kirkham to interest himself in producing one. In March, 1859, Kirkham patented a reversible lock which was suitable only for cheap rim locks. Finally, according to this witness, Kirkham visited Philadelphia, about Sept. 1st, 1860, and had with him a drawing, or sketch in pencil, showing the present invention. "Exhibit C," (one of only two locks of the kind ever made) "was sent to me about ten days or two weeks afterwards, and I had it in my possession up to the time that I sold the patent to Paul Chase Coffin." (Q. 6.)

Unquestionably Exhibit C is the identical lock which Kirkham at some time sent to Miller. It does not appear that Miller ever had but one lock in his possession of this kind. This one, so received, he kept for a considerable time in his desk. (Q. 16.) He has knowledge of not more than three or four that were made. (Q. 63.) When he sold the patent

to Coffin he delivered to him the lock which he had in possession. (Cross-Q. 19.) Coffin, the complainant, into whose hands the lock sent to Miller is thus traced, does not appear to testify in the case and prove that Exhibit C, produced at the examination of Mr. E. S. Renwick by the complainant, is a different lock from the one which Miller received from Kirkham. We are authorized to conclude that the lock of which Miller testifies is the lock marked Exhibit C.

EXHIBIT C (Compl'ts. Kirkham lock) same as Cut fig. 1. p. 2, BEARS UPON ITS FACE THE REFUTATION of MILLER S TESTIMONY.

The cap of the lock bears the inscription cast upon its face, "PAT'D NOV. 6, 1860." (Cross-Q. 20.) The explanation is obvious. Squire & Parsons were manufacturing locks under Kirkham's patent of Nov. 6, 1860, which related to an improved lever spring, and cases like the one belonging to Exhibit C, were used. Kirkham sometime after Nov. 6, 1860—and we will presently see when—made his alleged invention and naturally put the works into one of the regular cases of the company instead of making a new case, which would be unnecessary.

It is quite certain that the case in question could not have been made until after the patent, whose date it bears had issued. A reasonable allowance after the date of the patent was known should be made for the time required to make the patterns. So that on the evidence and probabilities thus far, Miller must be mistaken by at least three months in his date.

There are certain other suggestions to be made on Miller's testimony which are proper in this connection before referring to the evidence which establishes beyond doubt when exhibit C was made.

The alleged exhibition to him of the drawing of the lock, and the sending to him of the model exhibit C, occurred within ten days or a fortnight of each other. This he insists upon throughout. (Q.6–10, Cross Q. 43–77, 88.) He fixes the time of Kirkham's visit to his store as Sept. 1st, 1860, but he refers to no circumstance except to the fact that he received a letter from the President of the company informing him that Kirkham would call upon him. This letter, however, is in no way connected with the subject of the invention. (Cross-Q. 97.) Kirkham was in Philadelphia once or twice during 1861. (Cross-Q. 39), and the statement of Miller rests solely upon his memory and not upon any corroborative circumstance. The drawing is not in existence, and all private letters between Kirkham and Miller are either lost or withheld. (Cross-Q. 59, 60, 61.)

Miller was examined fully upon the subject on the occasion of an interference declared by the Patent Office, and did not then testify to any completed lock of Kirkham's being in his hands within a fortnight after Sept. 1, 1860. (Cross-Q. 43–51.)

EXHIBIT C WAS NOT MADE UNTIL MARCH, 1861.

Miller having probably in his mind an impression that it was in the season of mild weather when he received the drawing, has confounded the Spring of 1861, with the Autumn of 1860.

WILLIAM ALLPORT (Record, page 51, 59,) testifies that he is a pattern maker, and was employed by the Squire & Parsons Company, 1859, 1860, 1861. About five or six weeks previous to April 1st, 1861, which latter date he fixes by reference to the circumstance of his moving from one house to another under peculiar circumstances, (Q. 12–20,) and also by the Presidential election, (Cross-Q. 44,) he was requested by A. M. Hill, the Superintendent of the Company, to make certain alterations in the pattern of the case of the lock. These alterations

and their purpose he fully explains. (Q. 16–23.) These alterations were necessary to adapt the case to the divided hub and the reversible latch. The lock case of Exhibit C must have been cast from this altered pattern. (Cross-Q. 48.)

ALBERT M. HILL (Record page 63,) testifies that he is Superintendent of a lock factory, and has acted during his life as moulder, pattern-maker, lock maker, and manager. He is now in the employ of the Jones & Nimick Manufacturing Co., of Pittsburgh. During 1860, and through the Spring of 1861, he was the foreman of the lock finishing department of the Squire & Parsons Manufacturing Co. He was intimately acquainted with Kirkham (Q. 6.)

Q. 8. State fully and particularly all that you know concerning the making of that invention or improvement by the said Kirkham, with particular reference to the time when such improvement was made by him?

A. I know that about the 1st of March, 1861, Mr. Kirkham came up to the finishing shop from the office below and went to a bin containing brass hubs for locks, and taking one, came with it accross to the pattern department, and commenced filing it close by where I was at work on patterns. I noticed him, and asked him what he was working at; he stated, in so many words, that he had an idea of a reversible lock, and he was trying to work it out, or words to that effect. I told him if he would tell me what he wanted to do I would work it out for him. He then commenced to explain that he wished to make a divided hub in such a manner that the latch might be drawn forward so as to be reversed.

Q. 9. What next took place that you recollect?

A. He then stated he had the thing roughly sketched on paper down in the office, and would go down and get it, as perhaps it might aid me in getting his ideas, and he did so.

Q 10. Please describe fully the sketch or drawing which he exhibited?

A. It was a rough sketch, very crude, and

one of several others which he had made upon the same paper—not with the design of making patterns from, but to see how different devices might appear to his own eye.

Q. 11. Did the said Kirkham request you to render him any assistance in working out his idea; and if so, state what, if anything, you did for that purpose?

A. At my suggestion he gave the thing entirely into my hands. I made a wooden pattern to make one portion of the hub from, and the other portion was the part that he was at work with. I stated to him that he had better give it up to me; for the reason that it would require a wooden pattern to be made for the other part of the hub.

Q. 12. By reference to what circumstances are you able to fix the time as the 1st of March, 1861, when Kirkham exhibited his invention to you, and when you assisted him, as you have stated, in working out his idea?

A. Particularly from the fact that at that time we were very busy with our Spring orders, so much so that to gain time to work upon this pattern I went to the factory after working hours in the evening, that I might be undisturbed by the frequent calls made upon me during the day in my capacity as foreman. I can fix the year very certainly by the fact that it was in May of this same year that the factory ceased operating.

Q. 13. How long a time was occupied in the getting out the patterns?

A. I should say not more than two weeks.

Q. 14. During that time state whether you had conferences on the subject with Mr. Kirkham?

A. I did.

Q. 15. Did his idea require explanation, or was the structure manifest from the sketch?

A. After his first explanation I comprehended pretty fully what he desired, without reference to the sketch, or further explanations.

Q. 16. Were you acquainted with William Allport, and did he have any employment at this time in the factory?

A. I was. He was employed as pattern maker.

Q. 17. State whether, in connection with the improvement required to be made in the hub, any work was required to be done upon the case within which such works were to be placed; and if so, what was required?

A. Some slight alterations suggested themselves, in order to adapt the case to the proper working of this divided hub. I do not remember particularly what they were, except one alteration to allow the end of the latch spring to rest in a V-shaped notch or slot, instead of swinging around against a round stump when the latch is drawn forward.

Q. 18. Do you recollect by whom such changes in the case were made?

A. The changes in the case, which were slight, were all made by said Allport.

Q. 19. How many models, or completed locks were made, at or about this time, exhibiting the Kirkham improvement?

A. There were certainly two, and, if I remember right, but two.

Q. 20. State what was done with those models so made, if you know?

A. One model was sent to Munn & Co., in connection with an application for a patent, and, I suppose, went to Washington. My impression is, that the other was sent to Charles A. Miller, of Philadelphia.

Q. 21. Please look at the model now shown you, marked Complainants' Exhibit C., J. G., Jr., and state whether you recognize the same as a lock which you have ever seen before?

A. Most certainly.

Q. 22. State when and where, and what you know about it?

A. It is one of the two models made in the Spring of 1861.

Q. 23. Are you confident that it is

A. I am.

Mr. Hill also speaks of the difference between the construction of the Patent Office model and Exhibit C, and explains the reason, and concludes that Exhibit C was by some two weeks the later of the two. (Q. 26.)

Kirkham expressed a desire to patent his invention, and his object in making one of the models was to accompany his application. The facts stated by Hill and Allport, in connection with the date of Kirkham's applications for a patent, make it certain that neither drawing or model had any existence earlier than March, 1861.

The claim to September 1, 1860, as the date of the Kirkham invention, rests solely and entirely on the testimony of Miller.

It is charitable to this witness to say that he is mistaken in the statement that Kirkham showed him a drawing of his improvement so early as September, 1860.

The burden of proof upon this part of the case is shifted to the complainant.

With the evidence so clear and palpable before the Court, that Miller was mistaken by at least six months in his statement as to the time when he received Exhibit C, it would not seem that any greater reliance should be placed upon the accuracy of his statement as to the drawing.

The drawing is not produced, and there is therefore no means, as in the case of the lock, of convicting him of error.

The probabilities are all against the supposition that the drawing preceded the making of Exhibit C by more than a fortnight.

> ALBERT M. HILL (Record 63) Ans. to Q. 9: "He then stated that he had the thing roughly sketched on paper down in the office, and would go down and get it, as perhaps it might aid me in getting his ideas, and he did so. Ans. to Q. 10: It was a rough sketch, very crude, and one of several others which he had made on the same paper—not with the design of making patterns from, but to

see how different devices might appear to his own eye."

This, it will be remembered, was March, 1861. Mr. Hill was *intimate* with Kirkham. (See Ans. to Q. 6.)

Q. 29. Before the time that you have referred to as the occasion when Kirkham exhibited his improvement to you, had you heard from any source that Mr. Kirkham had made any improvement of this character in reversible latches, or had any drawings of this improvement?

A. I had not.

Q. 30. Have you any reason for supposing that the sketch shown to you by Mr. Kirkham preceded by any considerable time the making of the model, and what facts are within your knowledge from which an inference can be drawn as to the length of time that the sketch preceded the model?

A. I have no such reason. I would infer from the manner of his speaking of his sketch that it had not been made more than two or three hours previous, at the outside."

Miller himself, after he had been apprised of his blunder as to the date of the Exhibit C, still persists in the statement, that to the best of his recollection the model Exhibit C, and the drawing were only ten days or two weeks apart.

Ans. to Q. 77. (p. 20). "To the best of my recollection, it was ten days or two weeks after showing me the drawing that he sent me a lock that was, as far as I could tell, like the drawing; it had a divided hub like Exhibit C, which allowed the arms of the hub to be relieved so as to reverse or turn the latch."

Kirkham considered the invention of value, and was in haste to get a patent. Is it probable that the invention was allowed to slumber in a drawing for six months?

Miller says, Cross-Q. 99. "Did you not both consider that it was an invention which ought to be patented promptly?
A. Certainly we did."

A model for the Patent Office was, in fact, made at or about the same time as Exhibit C (Hill, 19-22.)

Miller says the drawing was in pencil, but that the invention was clearly shown by it (Miller, Cross-Q. 89, 90.)

Is it likely, in view of the circumstance that Miller and Kirkham were designing to start a rival lock establishment in Philadelphia, and that both considered the invention a valuable one, that an interval of seven months could have elapsed between the drawing and application for the patent without Miller remembering the fact? But it is certain that this time did intervene if Miller is correct in his statement that he saw the drawing in September, 1860. As before stated, his abiding impression is that only ten days or a fortnight elapsed between the two.

If there was any circumstance which could be referred to connected with the drawing, there would be more room for doubt; but in the absence of any, the irresistible conclusion is, from the testimony and the probabilities, that the drawing was made immediately preceding the making of Exhibit C, which is proved and admitted to have been made not earlier than March, 1861.

WE SUBMIT THAT IT IS PROVED:

1st. That Erbe made his invention as early as December 25, 1860.

2d. That Kirkham did not make his invention earlier than March 1-2, 1861.

3d. That both inventions exhibit the same mechanical principles, and are identical as contrivances to effect the reversal of the latch.

We do not apprehend that it will be denied that Erbe constructed a complete reversible latch, embodying the characteristics of the reversible latch made by the appellees, at least two months prior to the time of the alleged invention of Kirkham; but

we suppose that the argument for the appellant will be rested upon the proposition that if the proof fails to show that the Erbe lock, containing such reversible latch, was applied to use by being put upon a door, the invention was not reduced to practice.

There is some testimony to the effect that the Erbe lock was placed upon the door of the office of Jones, Wallingford & Co. Brosi (29, Cross 113) testified to the fact. Patterson (page 45, Q. 7) says that it was the uniform practice to put all new locks on the doors about the office to test them, and he believes this lock was so tested, but will not say positively. Erbe, who was examined by the complainant (page 23, Q. 8), is of the same belief.

In the view, however, which we take of the law, upon the subject of reduction to practice, and especially its application to a class of inventions like reversible latches, where the new thing can be exhibited only when the latch is *not* performing its proper duty as such, it is quite unimportant whether the Erbe latch was ever used upon a door or not.

WHAT REDUCTION TO PRACTICE OR USE OF THE THING INVENTED, ON THE PART OF A PRIOR INVENTOR, IS NECESSARY TO BE PROVED TO DEFEAT A SUBSEQUENT PATENT OBTAINED BY ANOTHER.

There is no pretence that more than two or three Kirkham latches were ever made, and these were intended as models; and we will assume the fact to be that only one Erbe latch was constructed before the date of the Kirkham patent, and that Brosi is mistaken in his statement of fact, and Patterson and Erbe in their belief that such latch was applied to a door.

It is conceded by the appellees that the machine or structure set up to defeat a subsequent patent, must be shown to have proceeded to completion, and to have embodied the alleged improvements.

It is admitted further, that its *capacity to perform the result*, which distinguishes the patented thing, must fully appear.

The patentee, under the 6th and 15th sections of Act, of 1836, (since re-enacted, sections 24 and 61, Act of 1870,) is not entitled to a patent if the thing claimed as new was "known or used by others before his or their discovery or invention thereof."

By "others" in the Statute is meant some *one* or more persons other than the patentee (*Reed* vs. *Cutter*, 1 Story, 590), and a knowledge or use by one person is as fatal to a subsequent patent, if clearly proved, as a knowledge or use by many persons.

Ordinarily, doubts are sought to be cast in these defences upon the capacity of the alleged prior structure to work out the same result as the thing patented, but here no such question arises.

The defendants submit that a *public*, in the sense of a *general*, use of a prior invention is not necessary to be proved to defeat a subsequent patent. Nor, in a case where the Court can see clearly that the structure set up to anticipate an invention must have been capable, from the manner in which it is proved to have been made, of working in a way which fully embodied the subsequently patented invention, is it incumbent to prove that it was actually subjected to use.

It is important to prove that an alleged prior machine was in fact used, because such use if attended with success in operation, presupposes a structure capable of exhibiting the combinations of mechanism subsequently patented, and greatly aids the proof as to the construction of the machine; but it is not indispensably necessary, as a matter of law, that such proof should appear. In the case of a complicated machine the absence of such proof would fur-

nish a violent presumption against the probability that the machine was capable of working successfully, but this is a matter of evidence only.

In *Bedford* vs. *Hunt*, 1 Mason, 302, Judge Story, in answer to the claim on the part of the plaintiff, that the thing set up to defeat a patent must be proved to have been generally known or in use, says: "I do not so understand the language of the Statute. To entitle a person to a patent as a first inventor, it is not necessary for him to establish that he has put his invention into general use. * * * And yet, upon the argument we are considering, unless it were so generally known and in use, he would be defeated by a patentee who was a subsequent, independent inventor. * * * But if the first inventor reduced his theory to practice, and put his machine or other invention into use, the law never could intend that the greater or less use in which it might be, or the more or less widely the knowledge of its existence might circulate, should constitute the criterion by which to decide upon the validity of any subsequent patent for the same invention."

This case does not decide that actual use is *necessary* to be shown, but that prior actual use, when proved in a single instance, is enough to defeat a patent. It does decide that a mere undemonstrated speculation cannot defeat a subsequent patent, but it does not assume to say that the law holds every thing in mechanics to be a speculation which cannot be proved to have been put to use. In harmony with this is the case of *Reed* vs. *Cutter*, 1 Story, 590.

In *Washburn* vs. *Gould*, 3 Story, 122, Judge Story says: "At any rate, he is the inventor who is entitled to a patent, who first brought the machine to perfection and made it *capable* of useful operation."

In *Ransom* vs. *Mayor*, 1 Fish., 270, Judge Hall says: "The party who embodies the principle and

makes it available for practical use, is the party who is entitled to a patent and to protection under the Patent Law."

In *Parkhurst* vs. *Kinsman*, 1 Blatch., 488, the previous machine was a *model* only. There was a grave doubt whether it was capable of accomplishing that which the patented invention did; but in this case the Court do not declare that actual use is necessary, but only, "To constitute a prior invention, the party alleged to have produced it must have proceeded so far as to have reduced his idea to practice, and embodied it in some distinct form. It must have been carried into practical operation," etc., meaning that the thing done must be a contribution to knowledge as distinguished from a "crude and imperfect experiment equivocal in results," etc.

Gayler vs. *Wilder*, 10 How., 498, does not limit or qualify the law pronounced in *Reed* vs. *Cutter*, as to the fatal effect upon a patent of a knowledge of the thing claimed as new, previous to the invention by the patentee, on the part of a single person who has not forgotten such knowledge once had.

In *Many* vs. *Jagger*, 1 Blatch., 383, each one of the wheels alleged to have been constructed before the invention of the patentee were proved by the alleged inventor of them to have been failures.

The Court, upon this part of the case, says the "new idea must be reduced to some practical use," *i. e.*, put into a form in which it is adapted for use.

In *Sickels* vs. *Borden*, 3 Blatch., 538, Judge Nelson instructs the jury that the invention "must be embodied into working machinery and *adapted to practical use;*" not that after the proof of such embodiment, it must further appear that the machine was, in fact, used.

Parker v Ferguson 1 Blatchford 470.

In *Cahoon* vs. *Ring*, 1 Clifford, 592, the alleged prior machine was a mere model, which was subsequently locked up in the inventor's chest. The want of evidence of practical use raised a fair presumption against its fitness for use.

In *Agawam Co.* vs. *Jordan*, 7 Wallace, 583, Mr. Justice Clifford says: "He is the inventor, and is entitled to a patent, who first brought the machine to perfection and made it *capable* of useful operation."

In *Whiteley* vs. *Swayne*, Mr. Justice Nelson says: "For he is the first inventor, and entitled to a patent, who, being an original discoverer, has first perfected and adapted the invention to actual use."

That actual use for business purposes cannot be indispensable, in a case where the actual completion of the thing obviously capable of being so used is admitted or sufficiently proved, must be clear, from a slight consideration. Suppose two persons, one residing in Illinois and the other in Maine, have each, independently of the other, made an improvement in grass harvesters. The inventor residing in Illinois has procured a patent for the improvement, and has had the opportunity, by reason of the grass crop maturing earlier in his neighborhood, of putting his machine into the field three weeks earlier than his competitor. The inventor residing in Maine is, in fact, the first to conceive the improvement and embody it in a machine obviously capable of working. Is it to be supposed for a moment that the first inventor is to be deprived of his right, on account of the accident of residing under a higher parallel of latitude than his rival?

Reduction to practice means embodiment of an idea in form. The use of a thing invented is consequent upon the invention. Invention precedes, use follows. The law rewards invention and regards use, an evidence, and justly the highest evidence, of

the fact of an invention. The absence of use justifies, in a complex mechanism, the presumption of incapacity to be used, or authorizes the inference of abandonment, but both presumption and inference are open to be rebutted. (Curtis on Patents, Edit. 1867, Page 69, Sec. 87.)

The present case, however, does not call for a decision upon the question whether actual use of a machine for business purposes is indispensably necessary to establish completion, or, in other words, whether a legal "reduction to practice" necessarily involves use for practical purposes.

It is not necessary, even as a matter of evidence, to produce proof that a machine has been tested or put to use in a way, or under conditions, that would not call into exercise the new thing contained in it. It is surely enough to show that the use which proves the invention to have been complete, demonstrated that the new thing existed, and if, during the employment of the machine for practical uses, the invention contained in it is necessarily required for the successful operation of the machine to remain dormant, then it adds nothing to the evidence of the completeness of the invention, to prove that such machine was put to practical use. Thus, in this case, the invention consists of a latch, so combined with the operating mechanism that it can be reversed, so that the workman can put it upon either a right or a left hand door. After the latch has been applied to the door and the knob spindle inserted, so that the latch can be worked, it is impossible, as well as improper, to reverse it. This case presents, therefore, an exceptionable instance of an improvement in a structure or machine, which improvement can only be shown to exist when the machine or structure is *not* applied to the use for which it was constructed. So soon as the workman, about to affix a reversible latch to a door, has set the latch face to suit the direction in

which the door swings, there ceases to be any further use for the exercise of the reversible quality of the latch. Its capacity to be reversed remains dormant forever after. Attaching such a latch to a door would not in any way test its ability to be reversed, and, therefore, any objection that, in this case, the evidence fails to fully show that the Erbe latch was affixed to a door for trial, is without weight.

ERBE'S INVENTION WAS REDUCED TO PRACTICE

in the only way in which it could be put to use. The lock containing such reversible latch was exhibited and inspected, and its ability to be reversed tried by persons whose credibility cannot be impeached, and, if it were necessary to ask this Court to hold that it must be proved that the lock was actually put upon a door, we should insist that the evidence of Brosi that such was the fact, and the statements of Erbe and Patterson as to their belief, coupled with the circumstance that the officers of the Jones & Nimick Manufacturing Company, have not been called to throw doubt upon the evidence, were amply sufficient.

The evidence as to the capacity of the latch to be reversed is explicit.

> BROSI—Q. 9. State whether the said Barthol Erbe has at any time heretofore exhibited to you any alleged improvement in reversible locks and latches; if yea, state the occasion when any such exhibition was made to you, and describe, as particularly as you can, the thing exhibited to you, and its structure?
>
> A. He has, in 1860. * * * He showed me the lock, how it worked, so that a person could use it right or left. He showed me the follower made in two pieces—one piece you take out when you take the knob away; the other part, the main part of the follower, slides forward in the case of the lock with the latch, so you can take the square part of the latch and turn it around left or right, whichever way a person wants to.

Q. 10. Did you examine this lock carefully at the time?

A. I did.

Q. 12. Had you ever seen a reversible latch before?

A. No, sir.

Q. 19. Was the lock shown to you by the said Erbe on the occasion mentioned, a complete lock capable of working?

A. It was.

MASTA—Q. 9. Did you examine the lock with the case open; if so, describe the lock, and how it operated?

A. Yes, I did, the lock. You had to pull out the spindle and the hub was fitted so that it would slide between the case and the plate, and let the latch forward.

Ans. to Q. 11. The whole hub was made of three pieces; one part was solid to the spindle or knob shank, and then the hub that slides between the plate and case and a washer at the other side of the spindle.

PATTERSON—Ans. to Q. 4. I have known Barthol Erbe since the year 1856, and been engaged in the same factory the major part of the time since then; he has at different times shown me alleged improvements in reversible latches; about the first of January, 1861, he showed me an improved reversible latch of his invention, like the model now shown me, marked "Defendants' Exhibit A;" the improvement in which consisted in constructing the hub or follower so that when the knob spindle was withdrawn the hub would slide forward between the cases, so that the head of the latch would protrude beyond the face of the lock, so as to permit its reversal from right to left; the latch head being connected with the yoke by a swivel joint, so that it might be reversed.

Ans. to. Q. 6. It was shown to me as a new invention, and I so regarded it.

Q. 9. State how in the lock shown you by Erbe at the time named, the hub or follower was made up?

A. The part of the hub which moved inside of the case was a single piece, with arms like

an ordinary follower or hub: there was on the shank or spindle a shoulder or boss, which filled the spindle-hole; on one side of the case there was also a loose ring or washer which slipped on the spindle from the other side, and held the spindle in the centre of the hole of the case on the other (plate of the) case.

Q. 37. Was the lock shown you by Erbe early in 1861 a complete working lock?

A. The latch part was complete. I am not clear whether there was a lock bolt in it or not; the latch and its connections were complete; it was unimportant whether there was a bolt or not.

Erbe's latch was not manufactured at once. Neither was Kirkham's. Jones, Wallingford & Co. were embarrassed financially. They were under an injunction on the Janus-faced case patent, and if the Erbe lock had been manufactured it would have infringed upon the supposed claims of that patent.

Vide PATERSON, page 47.

Answer to Cross-Q. 22. "Neither of" (the locks mentioned in answer to Cross 12) "can be properly used without a Janus-faced case."

Q. 38. You have referred to the fact that at a certain time Jones, Wallingford & Co. were enjoined against the Janus-faced case; state, if you know, why said company did not proceed to manufacture the Erbe lock, which would not be an infringement of the Janus-faced case; and also state, if you know, when they recommenced to manufacture the Janus-faced case, and why?

A. The Erbe lock would be necessarily an infringement of the Janus-faced patent, and for that reason they did not begin to manufacture until after the injunction was dissolved.

The case of *Jones* vs. *Morehead*, reported in 1 Wall., 156, which was an appeal from the decree wherein the injunction was ordered, was not decided until December term, 1863.

For the foregoing reasons, we claim that the decree of the Court below should be affirmed.

BENJ. F. THURSTON,
STEPHEN D. LAW,
Of Counsel for Appellees.